

REMARKS/ARGUMENTS

Applicant has carefully reviewed the Office Action mailed on July 8, 2008 wherein claims 1-63 are pending, claims 2-5, 12-14, 21-22, 30-31, 38-39 and 44-63 were withdrawn from consideration, and claims 1-2, 6-11, 15-20, 23-29, 32-37, and 40-43 have been rejected. In this amendment, claim 1 has been amended and claim 2 has been canceled. Claims 1 and 3-63 remain pending. No new matter has been added. Favorable consideration is respectfully requested in view of the amended claims and the following comments.

Information Disclosure Statement

Examiner notes that a number of cited foreign references did not have copies present in the application and requested that Applicant submit copies for consideration. Applicant respectfully submits that the documents were filed with the Office and confirmed via receipt, but do not appear to have reached the Examiner. Courtesy copies are being provided for the Examiner's consideration.

Double Patenting – 35 U.S.C. 101

Examiner advised that should claim 10, and those depending therefrom, be found allowable, claim 1, and those depending therefrom, will be objected to under 37 C.F.R. 1.75 as being a substantial duplicate thereof.

“A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).” (MPEP 804 II-A)

Applicant submits that claim 10 could be literally infringed by a device with 2 or 3 joining elements, and not literally infringe claim 1. Additionally, the possibility exists that a device with 4 (now at least 10, in view of the current amendment) joining elements that literally infringes claim 1 may not infringe claim 10.

Therefore, Applicant submits that independent claims 1 and 10, along with their dependents, do not claim identical inventions.

Claim Rejections – 35 U.S.C. 102

On page 4 of the Office Action, claims 1, 6-8, 10, 15-17, 19, 23-25, 28, 32-34, 36, and 40-42 were rejected under 35 U.S.C. 102(b) as being anticipated by Urick et al. (U.S. Patent No. 5,497,783). Applicant notes that a typographical error in the Office Action made the rejection to U.S. Patent No. 5,947,783 (to Bojkov et al.) and assumes that the corrected Urick et al. reference above was the intended citation. After careful review, Applicant respectfully traverses the rejections.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (MPEP 2131).

Independent claim 1, in this amendment, has been amended to include the limitations of claim 2. As such, claim 1 now recites:

1. (Currently Amended) An intracorporeal device comprising:
 - a) a helically wound coil having a plurality of windings forming a coil length; and
 - b) ~~[[four]]~~ at least ten joining elements disposed along the coil length, wherein each joining element couples two or more coil windings.

Urick et al. do not appear to disclose a device comprising a helically wound coil having a plurality of windings and at least ten joining elements wherein each joining element couples two or more coil windings. Therefore, since all claimed elements do not appear to be present in the cited reference, Applicant submits that claim 1 is not anticipated by Urick et al. and respectfully requests that the rejection be withdrawn.

Similarly to independent claim 1 above, claims 6-8, which depend therefrom and add additional elements thereto, are submitted as not anticipated by Urick et al. Applicant requests that the Examiner withdraw the rejections.

Regarding independent claim 10, Applicant submits that the claim recites “wherein each joining element only couples two or more coil windings.” (emphasis added) In accordance with the Examiner’s comments, Applicant notes that the reference numerals of Urick et al. do not match up exactly with the drawings. Urick et al. appear to disclose a guidewire 54 with “reenforcing points 56 and 58 are similarly soldered or brazed to complete

the attachment of distal helix 32 to core wire 10" (column 6, lines 38-40). Applicant submits that the joining elements of the claimed invention do not attach the coil windings to the core wire, but rather "each joining element only couples two or more coil windings", therefore claim 10 is not anticipated by Urick et al., and Applicant respectfully requests that the rejection be withdrawn.

Similarly to independent claim 10 above, claims 15-17, which depend therefrom and add additional elements thereto, are submitted as not anticipated by Urick et al. Applicant requests that the Examiner withdraw the rejections.

Independent claims 19, 28, and 36 all recite, in part, "a plurality of joining elements disposed on only a portion of the outer perimeter and along the coil length, wherein each joining member couples two or more coil windings." (emphasis added) Similar to claim 10 above, Urick et al. appears to disclose a guidewire 54 with "reenforcing points 56 and 58 are similarly soldered or brazed to complete the attachment of distal helix 32 to core wire 10" (column 6, lines 38-40). Applicant submits that the reinforcing points of Urick et al. appear to be disposed on the helix and the core wire, whereas the joining elements of the claimed invention are not disposed on the core wire, but "on only a portion of the outer perimeter and along the coil length". Therefore independent claims 19, 28, and 36 cannot be anticipated by Urick et al., and Applicant respectfully requests that the rejections be withdrawn.

Accordingly, Applicant submits that claims 23-25, 32-34, and 40-42, which depend from claims 19, 28, and 36 respectively and add additional elements thereto, are believed to be not anticipated by Urick et al. As such, Applicant requests that the Examiner withdraw the rejections.

Claim Rejections – 35 U.S.C. 103

On page 6 of the Office Action, the Examiner has rejected claims 2, 9, 11, 18, 20, 26, 27, 29, 35, 37, and 43 under 35 U.S.C. 103(a) as being unpatentable over Urick et al. (U.S. Patent No. 5,497,783). After careful review, Applicant respectfully traverses the rejections.

"All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (MPEP 2143.03).

On page 6 of the Office Action, the Examiner admits that the elements of these claims are not disclosed by the cited reference. Applicant also submits that independent claims 1, 10, 19, 28, and 36 are patentable for at least the reasons previously discussed. Therefore, claims 9, 11, 18, 20, 26, 27, 29, 35, 37, and 43, which depend therefrom and add additional distinguishing elements thereto, are also believed to be patentable over Urick et al. and Applicant requests that the rejections be withdrawn. In this amendment, claim 2 has been canceled, rendering the rejection of this claim moot.


Reexamination and reconsideration are respectfully requested. It is submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is also respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By his Attorney,

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